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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/964,257 11/04/97 TERASHIMA

H 56356

LM31/1223

MOGLEW AND TUTTLE  
SCARBOROUGH STATION  
SCARBOROUGH NY 10510-0827

EXAMINER

NGUYEN, M

ART UNIT

PAPER NUMBER

2722

DATE MAILED:

12/23/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 09/29/99

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 7-10, 19-25, 34-60 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 7-10, 19-25, 34-60 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on 09/29/99 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 14

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### DETAILED ACTION

This communication is responsive to amendment filed on October 13, 1999.

Applicant cancels claims 1-6, 11-18, 26-33, amends claims 7-10, 19-25, and add new claims 34-60.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 7-10, 19-25, 34-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanoue et al (US Patent No. 5,884,117).

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Concerning claim 34, Tanoue et al discloses an apparatus comprising a base apparatus which includes a first sheet transporting mechanism, a scanner apparatus which can be removably and includes a reading element, wherein a second sheet transporting path extending substantially vertically is defined by a surface of the scanner apparatus. The first and second sheet transporting mechanism are provided along and adjacent to each other.

Tanoue does not mention that the scanner apparatus may be detached from the base apparatus so as to operate as a hand scanner. However, Tanoue teaches that the scanner apparatus 90 can be attached to or detached from the base unit 1 (col. 10, lines 19-26). In another embodiment, Tanoue teaches that the scanner apparatus 90 is formed with a lower horizontal surface 90d, and accordingly, when the scanner apparatus 90 is removed from the base unit 1, and is placed on such a horizontal plane, it can be used independently (col. 12, lines 28-42). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to consider that the scanner apparatus 90 in Tanoue et al can be detached from the base unit 1 so as to operate as a hand scanner, since Tanoue teaches that the image-reading unit 90 can be used in either state as attached to the body 1 or as removed from the body 1 for independent use according to the user's demand, there can be provided the multi-functional image forming apparatus which can be readily operated by many users irrespective of service places and applications therefor (col. 12, lines 37-42).

Concerning claims 35-37, Tanoue further teaches that the scanner includes at least one pick up roller, a protecting member provided at a location outside of a reading area of the scanner

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apparatus 90, wherein the first and second sheet guides face each other in a manner that the space between them gradually narrow (Figs.1, 3-6).

Concerning claim 38, Tanoue et al discloses a multiple function apparatus comprising a first transport mechanism (front side Q) including a straight guide (91) and a deflecting guide (90), a second transport guide (rear side P) provided along the first transporting guide (front side Q); a first apparatus (90) provided at the straight guide, a second apparatus (40) provide in a space defined by the deflecting guide and a portion of the second transporting guide.

Tanoue fails to directly mention that the second transporting guide is provided in a manner that a distance between the deflecting guide becomes longer than that of the straight guide. However, from Fig.1, the distance between the deflecting guide 30 can be longer than that of the straight guide since the paper has to travel through the deflecting guide a distance longer than that of through the straight guide. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to consider that the second transporting guide is provided in a manner that a distance between the deflecting guide becomes longer than that of the straight guide in order to insert the first and second apparatuses 40 and 50 in order to make the system more compact.

Concerning claims 39-45, Tanoue et al further teaches that the first apparatus 90 is opposite to the second transporting guide (P) and the direction of transport of the first sheet is effected by the straight guide and a direction of transport of the second sheet effected by a portion of the second transporting guide which faces to the straight guide form an angle smaller than 90

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degrees with the vertical direction. Tanoue further teaches a first transport mechanism (20, 34, 38), a second transport mechanism (12-13, 35, 36), a first sheet delivery port (90b), a second sheet delivery port (C), wherein the first apparatus 90 is a scanner and the second apparatus 40 is a printer and the first and second apparatuses are provided in such a positional relation as to overlap each other vertically direction (Figs.1-7).

Concerning claims 7-10, Tanoue discloses the subject matter as discussed in claims 31 and 41. Tanoue further teaches that the scanner apparatus 90 includes a pick roller and feed rollers (92, 90b), protecting member (body of the scanner 90), accommodating part (91).

Concerning claims 19-23, Tanoue discloses the subject matter as discussed in claims 7-10. Tanoue further teaches an engaging portion (2), a pivotal shaft (2a) for allowing the scanner apparatus to rotate frontwards, a lock (2b), a rotation limiting stopper (90a), (Figs.1-6)

Concerning claims 46-49, Tanoue discloses the subject matter as discussed in claims 19-23 above.

Concerning claims 24-25, 50-60, Tanoue discloses the subject matter as discussed in claims 7-10, 19-23 above.

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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a. Yamada et al (US Patent No. 5,559,609) discloses a facsimile transceiver capable of assembling an image reading system concurrent with assembly of a main body of the facsimile transceiver.

b. Gaarder et al (US Patent No. 5,954,326) teaches a three-state shifting device for multi-function office equipment including ADF and ASF feeding sheets.

c. Nishiyama et al (US Patent No. 5,579,099) teaches a document conveying device and document reading device operable therewith.

4. Applicant's arguments with respect to claims 7-10, 19-25, 34-60 have been considered but are moot in view of the new ground(s) of rejection.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine Anh-Vinh Nguyen whose telephone number is (703) 305-4860.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Box AF  
Commissioner of Patents and Trademarks  
Washington, DC 20231


or faxed to:

(703) 308-9051 (for formal communications intended for entry; please mark "EXPEDITED PROCEDURE")

(703) 308-5397 (for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two  
2121 Crystal Drive  
Arlington, VA.  
Sixth Floor (Receptionist)



**MADELEINE NGUYEN  
PATENT EXAMINER**

December 20, 1999

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